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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/522,341   | 03/09/2000  | David Leigh Donoho   | UNIV0001            | 3293             |
| 22862  | 7590        | 10/24/2003           |                     |                  |
| GLENN PATENT GROUP<br>3475 EDISON WAY, SUITE L<br>MENLO PARK, CA 94025 |             |                      | EXAMINER            | CARDONE, JASON D |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2142                |                  |

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/522,341             | DONOHO ET AL.       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Jason D Cardone        | 2142                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 September 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 16-23 and 37-44 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15,24-36,45 and 46 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 March 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .      |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input checked="" type="checkbox"/> Other: <i>See Attached Office Action</i> . |

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 16-23 and 37-44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 10. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.
  
2. Claims 1-15, 24-36, 45 and 46 are presented for examination.

***Specification***

3. The statuses of the parent applications [Specification, page 1] need to be included and updated.

***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 24, and 45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,356,936 and claims 1-3 of U.S. Patent No. 6,604,130. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patents contain the same subject matter as the instant application. The patents disclose communication systems with more features than that of the instant application. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to eliminate the additional features in the communication systems, disclosed by the patents, based on legal precedent. The omission of an element and its function is obvious if the function of the element is not desired. *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-15, 24-36, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson, U.S. Patent No. 5,649,186, in view of O'Neil et al. (hereinafter O'Neil), U.S. Patent No. 5,987,440.

Regarding claim 1, Ferguson discloses In a system including an advice consumer for gathering broadcast information from a communications medium and a reader associated with the advice consumer for determining relevance of the broadcast information, a communications system comprising: an advice provider which broadcasts information over a communications medium to target situations based on an arbitrary combination of computationally verifiable conditions of an advice consumer computer and its environment [Ferguson, col. 3, lines 39-60, col. 5, lines 1-14 and col. 5, line 46 – col. 6, line 35]; wherein the advice consumer is advised of the information only if the information meets certain predetermined relevance criteria [Ferguson, col. 5, lines 1-14 and col. 5, line 46 – col. 6, line 35].

Ferguson does not specifically disclose the advice provider offers highly targeted advice without compromising individual privacy and the environment includes data of a sensitive or private nature. However, O'Neil, in the same field of endeavor, discloses a provider that offers highly targeted advice without compromising individual privacy and

the environment includes data of a sensitive or private nature [O'Neil, col. 2, lines 1-63, col. 5, line 26 – col. 6, line 64, col. 39, line 39 – col. 40, line 37, col. 40, line 59 – col. 41, line 6]. It would have been obvious to one having ordinary skill in the art, at the time the invention was made to incorporate security, taught by O'Neil, into the communication system, taught by Ferguson, in order to empower the user, at will, command and control of their personal information within network computing environments.

9. Regarding claim 2, Ferguson-O'Neil further discloses the relevance criteria further comprising: a set of any of demographic, biologic, geographical, and other empirical models used to infer statistically that a certain condition is highly likely to be true, even when it cannot be verified by direct calculation, measurement, or formal logical deduction, by using any of information which may be publicly available, information present in a user profile, information directly measurable, or information available from third parties [Ferguson, col. 5, line 46 – col. 6, line 35] [O'Neil, col. 40, line 29 – col. 41, line 30].

10. Regarding claims 3-6, Ferguson-O'Neil further discloses financial data, transaction data and health or medical data, wherein the relevance criteria comprise assertions that certain combinations of prescription drugs, certain interactions between genetic or blood type information or other personal medical history and certain behavior or illness or drug prescriptions [Ferguson, col. 3, lines 39-60] [O'Neil, col. 10, lines 46-60].

11. Regarding claim 7, Ferguson-O'Neil further discloses an inspector library containing executable code which is invoked as part of a continual relevance evaluation process; and one or more remote inspector methods for remotely performing any of mathematico-logical calculations, executing computational algorithms, returning the results of system calls, accessing the contents of storage devices, and querying the communicating devices [Ferguson, col. 5, line 46 – col. 6, line 35] [O'Neil, col. 40, line 29 – col. 41, line 30].

12. Regarding claim 8, Ferguson-O'Neil further discloses the one or more remote inspector methods comprising any of medical records inspectors, remote financial records inspectors, and remote drug prescription inspectors [Ferguson, col. 3, lines 39-60] [O'Neil, col. 10, line 46 – col. 11, line 63].

13. Regarding claims 9, 14 and 15, Ferguson-O'Neil further discloses the one or more remote inspector methods comprise any of server side components and client side components, a connection between the client and the server is secured by a cryptographic protocol, and the identity of a client requesting information is authenticated by a server using an authentication protocol [Ferguson, col. 6, line 49 – col. 7, line 6] [O'Neil, col. 6, lines 24-52, col. 50, line 60- col. 51, line 33 and col. 54, line 44 – col. 55, line 64].

14. Regarding claims 10 and 11, Ferguson-O'Neil further discloses the one or more remote inspector methods comprise server side components for providing remote information access, wherein a consumer receives advice via the remote information access, and the consumer's personal information is included in the server side components, only if the consumer authorizes inclusion of the consumer's personal information in the server side components [Ferguson, col. 3, lines 39-60] [O'Neil, col. 47, line 48 – col. 48, line 51].

15. Regarding claim 12, Ferguson-O'Neil further discloses a consumer subscribing to advice sites, which make use of the remote inspectors [Ferguson, col. 3, lines 39-60] [O'Neil, col. 47, line 48 – col. 48, line 51].

16. Regarding claim 13, Ferguson-O'Neil further discloses a remote inspector method on a consumer machine establishes a connection with an information server and performs one or more queries to determine if relevant information is present on the information server with regard to the consumer; and wherein the information is gathered by the server [Ferguson, col. 5, lines 1-14 and col. 5, line 46 – col. 6, line 35] [O'Neil, col. 33, line 27 – col. 38, line 34].

17. Regarding claims 24-36, 45 and 46, claims 24-36, 45 and 46 have similar limitations as claims 1-15. Therefore, the similar limitations are disclosed under

Ferguson-O'Neil for the same reasons set forth in the rejection of claims 1-15 [Supra 1-15].

***Conclusion***

18. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D Cardone whose telephone number is (703) 305-8484. The examiner can normally be reached on Mon.-Thu. (9AM-6PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Powell can be reached on (703) 305-9703. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Jason D Cardone  
Examiner  
Art Unit 2142

October 16, 2003